UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,843	08/22/2003	Jean-Guy Talbot	RP-01203-US3	8132

909 7590 08/18/2004

PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER	
ENGLISH, PETER C	

ART UNIT	PAPER NUMBER
3616	

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/645,843	TALBOT ET AL.	
	Examiner	Art Unit	
	Peter C. English	3616	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-23 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-23 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 22 August 2003 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 20030822; 20031117; 20031208
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

PE 8/16/04

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:

α, β, and γ, shown in Fig. 7.

2. The drawings are objected to because:

In Fig. 7, both occurrences of "PASSAGER" should be "PASSENGER".

3. Corrected drawings are required in reply to the Office action to avoid abandonment of the application. Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. The correction to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The specification fails to describe the distance N or P as being about "51 mm" (claim 2) or about "602 mm" (claim 3).

The specification fails to describe the distance Q or R as being about "470 mm to 1143 mm" (claim 4).

The specification fails to describe the distance R as being about "686 mm to 1410 mm" (claim 8) or about "1145 mm" (claim 9).

The specification fails to describe the distance G as being about "686 mm to 1143 mm" (claim 12) or about "905 mm" (claim 13).

The specification fails to describe the distance J or K as being about "457 mm to 927 mm" (claim 14) or about "739 mm" (claim 15).

The specification fails to describe the distance H or I as being about "152 mm to 483 mm" (claim 16) or about "243 mm" (claim 17).

The specification fails to describe the angle γ_1, γ_2 or γ_3 as being about "19 degrees to 59 degrees" (claim 19) or about "36.5 degrees" (claim 20).

The specification fails to describe the angle α_1, α_2 or α_3 as being about "52.59 degrees to 120.37 degrees" (claim 22).

Claim Rejections - 35 USC § 112

5. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, at lines 4-5 and 7, in claim 10, at lines 4 and 5-6, in claim 18, at lines 5 and 7, and in claim 21, at lines 5 and 7, "suitable for road use" renders the claim indefinite because one person's definition of "suitable" will differ from that of another person. Further, there are different types of road (e.g., paved vs. gravel); therefore, two different types of tires may be "suitable" for two different road types.

In claim 18, at lines 14-15, and in claim 21, at line 14, "the handlebar" lacks proper antecedent basis. Note that only a "steering mechanism" is previously recited.

Double Patenting

6. Claims 1-23 of this application conflict with claims 1-23 of Application No. 10/371,232. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and

useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1, 2, 4-8, 10-12, 14, 16, 18 and 21 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 4-8, 10-12, 14, 16, 18 and 21 of copending Application No. 10/371,232. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 3, 9, 13, 15, 17, 19, 20, 22 and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 9, 13, 15, 17, 19, 20, 22 and 23 of copending Application No. 10/371,232. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

In designing a particular vehicle, one of ordinary skill in the art would adjust the dimensions of the vehicle to suit the intended rider (i.e., a child vs. an adult), to suit the intended use (i.e., off-road vs. sport vs. cruising), and to suit one's particular taste (i.e., aesthetics). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify claims 3, 9, 13, 15, 17, 19, 20, 22 and 23 of copending Application No. 10/371,232 by providing the vehicle with the dimensions recited in 3, 9, 13, 15, 17, 19, 20, 22 and 23 of the instant application in order to adapt the vehicle to a particular user, a particular use and/or a particular taste. Further, such a modification involving a mere change in dimension is generally recognized to be within the level of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 6, 7, 10, 11, 18 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Townsend (US 4,351,410) or Trautwein (DE 3546073) or Kanamori (JP 60116572).

Townsend discloses a three-wheeled vehicle comprising: an engine 30 supported by a frame 22; front wheels 28 that are steered by a handlebar 46, a single rear wheel 24 that is driven by the engine 30, a seat 34 having a driver portion and a passenger portion (see Fig. 1), and footrests (see Fig. 1) for the driver and passenger.

Trautwein discloses a three-wheeled vehicle comprising: an engine (see Figs. 1-3) supported by a frame 2; front wheels 4, 5 that are steered by a handlebar 10, a single rear wheel 3 that is driven by the engine, a seat (see Fig. 2) having a driver portion and a passenger portion (see Fig. 2), and footrests 11, 12 for at least the driver.

Kanamori discloses a three-wheeled vehicle comprising: an engine 50 supported by a frame 10; front wheels 35 that are steered by a handlebar 41, a single rear wheel 36 that is driven by the engine 50, a seat 71 having a driver portion and a passenger portion (see Fig. 1), and footrests 29, 31 for the driver and passenger.

Claim Rejections - 35 USC § 102/103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 2-5, 8, 9, 12-17, 19, 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Townsend (US 4,351,410) or Trautwein (DE 3546073) or Kanamori (JP 60116572), or in the alternative are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend or Trautwein or Kanamori.

Townsend, Trautwein and Kanamori (discussed above) fail to specify the dimensions recited in applicant's claims. In a first interpretation, the vehicles disclosed by Townsend, Trautwein and Kanamori are considered to inherently possess these dimensions.

In an alternative interpretation, Townsend, Trautwein and Kanamori are considered to lack the dimensions recited in 2-5, 8, 9, 12-17, 19, 20, 22 and 23. In designing a particular vehicle, one of ordinary skill in the art would adjust the dimensions of the vehicle to suit the intended rider (i.e., a child vs. an adult), to suit the intended use (i.e., off-road vs. sport vs. cruising), and to suit one's particular taste (i.e., aesthetics). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Townsend, Trautwein or Kanamori by providing the respective vehicle with the dimensions recited in 2-5, 8, 9, 12-17, 19, 20, 22 and 23 in order to adapt the vehicle to a particular user, a particular use and/or a particular taste. Further, such a modification involving a mere change in dimension is generally recognized to be within the level of ordinary skill in the art.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hare, Cizek, Ethier, Badsey and Huber teach three-wheeled motor vehicles.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. English whose telephone number is 703-308-1377. The examiner can normally be reached on Monday through Thursday (7:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul N. Dickson can be reached on 703-308-2089. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Peter C. English 8/16/04
Primary Examiner
Art Unit 3616

pe
August 16, 2004